

DETAILED ACTION

(1)

Status of Claims

Claims 1, 3, and 6-17 remain for examination wherein claim 1 is amended.

(2)

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 103

The rejection of claim 1, 3, 6-7 and 9-14 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U. S. Patent No. 4,882,133 to Saegusa as generally set forth in the first office action mailed 03/21/2008 stands.

The rejection of claims 1, 7-8 and 17 under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 4,882,133 to Saegusa, in view of WO 02/24153 to Nishihama as generally set forth in the first office action mailed 03/21/2008 stands.

The rejection of claims 6, 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 4,882,133 to Saegusa, in view of U.S. patent No. 5,500,216 to Julian et al. as generally set forth in the first office action mailed 03/21/2008 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

(3)

Declaration

The Declaration under 37 CFR 1.132 filed on 03/21/2008 is insufficient to overcome the rejection of claims based upon U. S. Patent No. 4,882,133 as set forth in the last Office action because: The experimental data is not based on the mixed oxide set forth in the Saegusa reference and only compares to a single oxide, SiO_2 .

(4)

Response to Arguments

Applicant's arguments filed 03/21/2008 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 1, 3, and 6-17 as indicated in the first Office Action stand.

Applicants argue that Saegusa is silent about the specified surface area, average aspect ratio, and peak fine pore diameter of the mixed oxide. The examiner respectfully submits that it is the position of the examiner that since the property(such as specified surface area, average aspect ratio, and peak fine pore diameter) is determined by process of making the composition, the claimed the property would be inherent to that of method of Saegusa. See MPEP 2112. Furthermore, the declaration filed by the applicants does not compare the mixed oxide of the Saegusa reference.

Applicants argue that Saegusa discloses a list of metal oxide. The Examiner respectfully submits that it is true that Saegusa discloses aluminum, silicon, titanium, zirconium and tin may be used in the composition. However, first a reference is not limited to the teaching in its preferred embodiment (A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the

teachings. In re Opprecht 12 USPQ 2d 1235, 1236 (CAFC 1989); In re Bode USPQ 12; In re Lamberti 192 USPQ 278; In re Bozek 163 USPQ 545, 549 (CCPA 1969); In re Van Mater 144 USPQ 421; In re Jacoby 135 USPQ 317; In re LeGrice 133 USPQ 365; In re Preda 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See In re Van Marter, 144 USPQ 421). Second, it is not picking and choosing to select one element from one list, however long the list may be. When the species is clearly named, the selection from a long list does not avoid a 103 rejection. See Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982). In the instant case, Saegusa discloses that the starting material is preferred selected from one or more member of Aluminum, silicon, titanium, zirconium and tin (col. 2, lines 13-15).

(5)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

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/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

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